

AMENDMENT TO THE DRAWINGS

The attached sheet of the drawing includes a change to Fig.1. The attached sheet replaces the original sheet. The change made to Fig.1 is as follows:

Fig.1 has been amended to change the term "TRANSMISSION MAIL SERVER" to ---TRANSMISSION MAIL SERVER---

Attachment: A Replacement Sheet

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 16, 19, 20, 21, 22, 23, 24, 25, and 26 will have been amended for consideration by the Examiner. Thus, claims 16-26 remain pending.

In view of the above, Applicant respectfully requests reconsideration of the outstanding objections and rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for the acceptance of the drawings filed in the present application on April 11, 2001. Further, Applicant would like to express his appreciation to the Examiner for conducting two interviews by phone on April 15, 2005 and April 21, 2005.

Turning to the merits of the action, the Examiner has objected to Fig.1 because of a misspelling. By the present amendment, Applicant has amended Fig.1 to correct the misspelling. Thus, Applicant respectfully requests that the Examiner withdraw the objection.

The Examiner has objected to claims 16, and 20-26 because of informalities. The Examiner points out that the term "the mail server" is not clearly pointed out to be either "the transmission mail server" or "the reception mail server" in Fig.3. As discussed in the interviews, it is not important for the features of the present invention whether the mail server is a transmission server or a reception server. Thus, Applicant

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has not amended claims 16, 20, 21, 22, 23, 24, 25, and 26 to clarify whether the mail server is a transmission server or a reception server.

However, Applicant has amended claim 19 to more clearly define Applicant's invention. In particular, Applicant has defined, in claim 19, that the mail server of claim 16 comprises at least a transmitting mail server and a receiving mail server. The newly amended claim 19 is submitted to clarify the features thereof. Additionally, as noted above, with respect to the independent claims whether the mail server recited therein is "a transmission" mail server or "a reception" mail server is not particularly relevant with respect to the features of Applicant's invention.

By the present amendment, Applicant has amended claims 16, 20, 21, 22, 23, 24, 25, and 26 to clarify that the scanner is distinct from the mail server, based on the proposal by the Examiner during the interview conducted on April 21, 2005. Thus, Applicant respectfully requests that the Examiner withdraw the objection as well as rejection.

The Examiner has rejected claims 16, 19, and 23 under 35 U.S.C § 102(e) as being anticipated by TOYODA_1998 (U.S. Patent No. 6,094, 277). The Examiner has also rejected claims 17 and 18 under 35 U.S.C § 103 as being unpatentable over TOYODA_1998 in view of TOYODA_1999 (U.S. Patent 6,778,287). The Examiner has also rejected claims 20 and 24 under 35 U.S.C § 103 as being unpatentable over TOYODA_1998 in view of YOSHIDA et al. (U.S. Patent 5,031,179). The Examiner has also rejected claims 21 and 25 under 35 U.S.C § 103 as being unpatentable over TOYODA_1998 in view of SHILLER et al. (U.S. Patent 6,442,573). The Examiner has

also rejected claims 21 and 25 under 35 U.S.C § 103 as being unpatentable over TOYODA_1998 in view of JOFFIE et al. (U.S. Patent 6,671,061).

As noted above, Applicant has amended claims 16, 19, 20, 21, 22, 23, 24, 25, and 26. Applicant respectfully traverses the above rejections based on pending claims 16-26 and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The newly added claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 16-22 generally relate to an electronic mail communication apparatus which transmits an e-mail to a destination via a mail server. The electronic mail communication apparatus comprises a scanner configured to scan image data and a memory configured to store a limit capacity of the mail server. The scanner is distinct from the mail server. The limit capacity indicates a maximum data amount that the mail server can store for one e-mail transmission. The electronic mail communication apparatus comprises a controller which converts the image data into data for Internet transmission, attaches the converted data to the e-mail, and transmits, to the destination, the e-mail to which the converted data is attached, via the mail server. Further, the controller compares the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server, and notifies a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server. Claims 23-26 recite a related method.

Regarding the rejection under 35 U.S.C. § 102(e) asserted by the Examiner, TOYODA_1998 relates to an Internet facsimile apparatus on the receiving side (col. 4, lines 6-16). The Internet facsimile apparatus of TOYODA_1998 checks whether a mail server receives a new e-mail, downloads e-mail data from the mail server, and stores the e-mail data in data area 28. The data area 28 has a capacity of 1 MB. The Internet facsimile apparatus decides whether one page is 1 MB or less. When the one page exceeds the capacity of data area 28, 1 MB, the Internet facsimile apparatus transmits, to the sender, an error message to which "Message ID" is attached (col. 5, lines 37-44).

However, although data area 28 of TOYODA_1998 has the capacity of 1 MB, data area 28 is a component of the RAM of the Internet facsimile apparatus but is not a component of or of a part of the mail server (Fig.2). Thus, TOYODA_1998 merely discloses storing the capacity of the Internet facsimile apparatus, but does not disclose storing the capacity of the mail server.

On the other hand, the present invention relates to an Internet electronic mail communication apparatus on the transmitting side. The Internet electronic mail communication apparatus transmits image data to a destination via a mail server, as cited in pending claims. The Internet electronic mail communication apparatus also stores a capacity of the mail server. The capacity recited in the claims of the present invention refers to the capacity of the mail server, but does not refer to the capacity of the Internet electronic mail communication apparatus itself. Further, regardless of whether the mail server is the transmitting mail server or the receiving mail server, the capacity of the transmitting mail server or the capacity of the receiving mail server

refers to the capacity of the mail server, but does not refer to the capacity of Internet electronic mail communication apparatus itself.

Thus, TOYODA_1998 does not disclose an electronic mail communication apparatus which store the capacity of the mail server. TOYODA_1998 also does not disclose an electronic mail communication apparatus which determines whether an amount of the image data to be transmitted exceeds the capacity of the mail server. In this regard, the present invention is clearly distinguished over TOYODA_1998.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 16, 19 and 23 are not disclosed in TOYODA_1998 cited by the Examiner.

Regarding the rejection of claims 17 and 18 under 35 U.S.C. § 103(a) by the Examiner, TOYODA_1999 relates to a communication apparatus which transmits a confirmation e-mail to the sender when image data which is attached to a receiving e-mail is printed out by a printer of the communication apparatus.

However, TOYODA_1999 discloses neither an electronic mail communication apparatus which store the capacity of the mail server nor an electronic mail communication apparatus which determines whether an amount of the image data to be transmitted exceeds the capacity of the mail server. Thus, the present invention is clearly distinguished over TOYODA_1999.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 17 and 18 are not disclosed in TOYODA_1999 cited by the Examiner. The pending claims are submitted to also be patentable over the Examiner's proposed combination, since TOYODA_1998 and TOYADA_1999 do not disclose the combination of features recited in Applicant's claims 17 and 18.

Regarding the rejection of claims 20 and 24 under 35 U.S.C. § 103(a) by the Examiner, YOSHIDA et al. relates to a data communication apparatus having an error re-transmission mode. YOSHIDA et al. teaches that encoded image information is divided into predetermined lengths so as to be converted into HDLC frames (col. 6, lines 42-62).

However, YOSHIDA et al. relates to a conventional facsimile apparatus, but do not relate to an electronic mail communication apparatus. YOSHIDA et al. does not contain any disclosure about an electronic mail communication apparatus. Thus, YOSHIDA et al. does not disclose an electronic mail communication apparatus which converts image data into data for Internet transmission, attaches the converted data to the e-mail, and transmits, to a destination, the e-mail to which the converted data is attached, via the mail server.

Further, YOSHIDA et al. does not disclose a mail server, the mail server including at least one of a transmitting mail server or a receiving mail server, since YOSHIDA et al. do not relate to an electronic mail communication apparatus. Thus, YOSHIDA et al. discloses neither an electronic mail communication apparatus which stores the capacity of the mail server nor an electronic mail communication apparatus which determines whether an amount of the image data to be transmitted exceeds the capacity of the mail server. Therefore, the present invention is completely distinguished over YOSHIDA et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 20 and 24 are not disclosed in YOSHIDA et al. cited by the Examiner. The pending claims are submitted to also be patentable over the Examiner's proposed

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combination, since TOYODA_1998 and YOSHIDA et al. do not disclose the combination of features recited in Applicant's claims 20 and 24.

Regarding the rejection of claims 21 and 25 under 35 U.S.C. § 103(a) by the Examiner, SCHILLER et al. relates to a method and apparatus for distributing picture mail to a frame device community. SCHILLER et al. teaches that a BMP image is converted into a JPEG image.

However, SHILLER et al. merely discloses a client computer which has a picture box, as shown in Fig.2A. The picture box merely includes information regarding status, image name, date, and sender, as shown in Fig.5. Thus, SCHILLER et al. discloses neither an electronic mail communication apparatus which store the capacity of the mail server nor an electronic mail communication apparatus which determines whether an amount of the image data to be transmitted exceeds the capacity of the mail server. Therefore, the present invention is completely distinguished over SHILLER et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 21 and 25 are not disclosed in SHILLER et al. cited by the Examiner. The pending claims are submitted to also be patentable over the Examiner's proposed combination, since TOYODA_1998 and SHILLER et al. do not disclose the combination of features recited in Applicant's claims 21 and 25.

Regarding the rejection of claims 22 and 26 under 35 U.S.C. § 103(a) by the Examiner, JOFFE et al. relates to a fax broadcasting system for use in packet switching network environment for transferring facsimile information in the form of multiple packets, received from a transmitting communication device, to a plurality of receiving communication devices. JOFFE et al. teaches that, when one of the receiving

communication device 22 or 24 is busy, the transmitting communication device 12 transmits fax information to other operational fax recipients.

However, JOFFE et al. merely teaches that, when one receiving communication device is busy, a transmitting communication device transmits fax information to another receiving communication device. JOFFE et al. does not contain any detailed disclosure about the transmitting communication device 12. JOFFE et al. merely describes the transmitting communication device 12 as a personal computer or a facsimile machine (col. 3, lines 24-26).

Thus, JOFFE et al. does not disclose an electronic mail communication apparatus which stores a limit capacity and an IP address corresponding to each of the plurality of the mail servers. JOFFE et al. also does not disclose an electronic mail communication apparatus which compares the data amount of the e-mail to which the converted data is attached with the limit capability of the designated mail server and selects another mail server that has a capacity to store the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the designated mail server. Therefore, the present invention is completely distinguished over JOFFE et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 22 and 26 are not disclosed in JOFFE et al. cited by the Examiner. The pending claims are submitted to also be patentable over the Examiner's proposed combination, since TOYODA_1998 and JOFFE et al. do not disclose the combination of features recited in Applicant's claims 22 and 26.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding objections and rejections, and an indication of the allowability of all the claims pending in the present application in due course.

As noted above, Applicant conducted two telephone interviews with Examiner Sunray Chang in charge of the present application. The first interview was conducted on April 15, 2005 and the features of the present invention were explained and the distinctions between the present invention and the references relied upon were set forth for the Examiner and for her Supervisor, who was present during the above-noted interview. At the conclusion of the first interview, the Examiner indicated that she would consider Applicant's arguments. Applicant's undersigned representative thanked the Examiner and also requested that the Examiner, if she found that the claims could be clarified by an appropriate amendment, feel free to contact Applicant's representative to suggest such amendment.

On April 21, 2005, Examiner Chang did in fact contact Applicant's representative and suggested that the independent claims be amended to clearly indicate that the scanner is distinct from the mail server. In response to the Examiner's suggestion, Applicant has amended each of the independent claims as set forth above to clarify this distinction.

Applicant respectfully wishes to thank both the Examiner and her Supervisor for their extreme courtesy and cooperation in scheduling and conducting the above-noted interviews. Applicant further wishes to express his appreciation and thanks to the Examiner for her open-minded approach to the features of the present invention and for

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her proactive attitude in contacting Applicant and suggesting language to more clearly define the distinctions between the present invention and the references relied upon.

Although the status of the application is after final rejection, Applicant submits that entry of the amendment is proper under 37 C.F.R. § 1.116. In particular, no new matter issues are being presented and no new claims are being submitted. It is assumed that the Examiner has searched and considered the present claim limitations as they were discussed in the specification.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the new claims with the disclosures of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

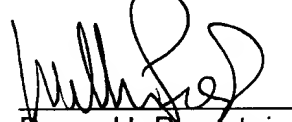
Applicant has further made of record two telephone interviews conducted between Applicant's undersigned representative and the Examiner in charge of the present application, and has thanked the Examiner for her cooperation during the above-noted interviews.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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